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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/018,769	12/21/2001	Sandrine Decoster	05725.0993	2464

22852 7590 03/27/2003

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EXAMINER

YU, GINA C

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 03/27/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/018,769

Applicant(s)

DECOSTER ET AL.

Examiner

Gina C. Yu

Art Unit

1617

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 18-51 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 18-51 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

DETAILED ACTION

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

1. Claims 18, 32-35, 40-45, 47, 49-51 are rejected under 35 U.S.C. 102(a) as being anticipated by Tian et al. (WO 99/13844) ("Tian").

Tian discloses a hair care formulation comprising 0.10 % by weight of behenyl alcohol, 0.20 % by weight of stearyl alcohol, and a 0.8 % by weight of triazinstilbene optical brightener. See Example 7. The formulation also contains 1.0 % by weight of polyquaternium –10, a cationic surfactant. See instant claim 40-44. The reference also teaches method of making a conditioning sprays, lotions, and conditioners with the formulation in Example 7. See p. 71, lines 6 – 16. The method of using the hair composition is an inherent in the product. See also p. 71, lines 17 – 19. Claim 47 is met since the claim defines the "suspension agent" as a composition comprising the C18 and C22 fatty alcohols and an opacifier or brightener, which read on the composition of Example 7.

2. Claims 18, 32-35, 40, 42-45, 47, 50 are rejected under 35 U.S.C. 102(b) as being anticipated by Asmus et al. (WO 97/00668) ("Asmus").

Asmus discloses a cream formulation comprising 0.25 % by weight of each of behenyl alcohol and stearyl alcohol, 0.5 % by weight of a surfactant (Brij 76), and an acyl compound (Decaglyn 1-S). See Examples 16 A and B; instant claims 18, 32-35, and 45. Promyristyl PM3, an emollient is also present. See instant claims 40, 42 - 44. The method of topically applying the cosmetic composition is inherent to the composition. See instant claim 50.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 18, 26-44, 46-51 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu et al. (WO 99/13830) ("Mitsumatsu").

Mitsumatsu teaches shampoo formulations comprising trizole, an optical brightener, and either stearyl alcohol or behenyl alcohol. See Examples 3-5. Detergent surfactants such as ammonium lauryl sulfate and cocamidopropylbetaine are used within the claimed amount. See instant claims 37-39. Conditioning agents such as silicone emulsion are used. See instant claims 40-44. See p. 45, lines 9 – 14 for the method of use. See instant claims 49-51.

While the example formulations do not concurrently use stearyl alcohol and behenyl alcohol within a same composition as recited in the instant claims, the Mitsumatsu patent suggests using cetyl alcohol, stearyl, behenyl alcohol, and mixtures

thereof. See p. 24, lines 16 – 20. These compounds, collectively named as “high melting point compounds” in the reference, are said to cover the hair surface and reduce friction, providing smooth feel and easy combing. See p. 23, line 31 – p. 24, line 15. The Example formulation 4 and 5 shows concurrent use of cetyl alcohol and stearyl alcohol in the ratio of 1:1 and 1:2, which renders the use of stearyl alcohol and behenyl alcohol within the claimed range obvious. See instant claims 32 – 34.

For instant claims 26-31, while the Mitsumatsu Examples do not show the recited weight range of the fatty alcohols, examiner notes that generally, differences in concentration will not support the patentability of subject matter encompassed by the prior art unless there is evidence indicating such concentration is critical. See MPEP § 2144.05. Since the general conditions of the instant claims are disclosed in Mitsumatsu, examiner views that one having ordinary skill in the art would have discovered the optimum or workable ranges by routine experimentation. Raising the concentration of an active component to enhance the effect of the “high melting point compounds” would have been obvious to the routineer.

2. Claims 19-25, 35, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mitsumatsu et al. (WO 99/13830) (“Mitsumatsu”) as applied to claims 18, 26-44, 46- 51 as above, and further in view of Sebag et al. (WO 98/03155) (“Sebag”).

Mitsumatsu, discussed above, fails to teach the opacifier/pearlescent recited in claims 19-25.

Sebag teaches hair washing and conditioning compositions comprising a dialkyl ether of formula (II) in instant claim 22, and preferably distearyl ether. See English equivalent of Sebag, US 6162423, col. 2, lines 26 – 53; col. 1, lines 4- 66. The reference teaches that the use of at least one fatty dialkyl ether used in the instant invention renders a washing foaming compositions having insoluble silicones and surfactants, pearlescent effect, good homogeneity, and improved stability while maintaining foaming power. See Example 1, which comprises 4 % by weight of stearyl ether and 1 % by weight of cetylstearyl alcohol.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the shampoo compositions comprising silicone emulsion in Mitsumatsu by substituting the triazole with distearyl ether as motivated by Sebag, because of the expectation of successfully producing shampoo compositions with similar pearlescent effect, good homogeneity with improved stability and foaming power.

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 18-51 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-45 of U.S. Patent No. 6521238 B1. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are directed to compositions containing an opacifier or pearlescent agent, fatty alcohols, conditioner, and a surfactant base, and a process of using thereof. For the fatty alcohol, the '238 patent teaches that a mixture of C18 and C22 fatty alcohol can be particularly used in the invention. See col. 3, lines 12-18.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Gina C. Yu whose telephone number is 703-308-3951.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan can be reached on 703-305-1877. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

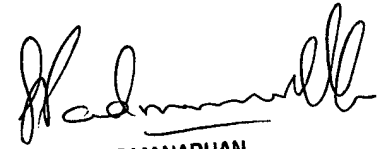
Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1234.

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Gina C. Yu
Patent Examiner
March 21, 2003



SREENI PADMANABHAN
PRIMARY EXAMINER

3/21/03